



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/733,891

12/11/2003

Patrick Young

ST-8 Div. 2 FWC Cont. 2

1556

75563 7590 04/30/2009

ROPES & GRAY LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

HASAN, SYED Y

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

04/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/733,891	Applicant(s) YOUNG, PATRICK	
	Examiner SYED Y. HASAN	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/11/2003 and 8/26/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. This application is in response to applicant objecting to the disclosure of Young (US 5151789) in a fax submitted by Tusher Parliker on April 20, 2009. Applicant claims that this prior art is a continuation of the present application. Examiner agrees. However upon further investigation, it was determined that this prior art was not needed to reject the claims mentioned below.
2. Applicant's arguments with respect to claims 1- 14 filed on 06/12/2008 have been considered but are moot in view of the new ground(s) of rejection.

In re page 3 applicant objects to using Young (US 5532754) as a reference because the issue date of April 11, 1994 is later than Young et al (US 5353121) which has an issue date of March 19, 1993. Applicant claims priority to this application, therefore examiner will respond to this claimed invention and application date.

The references being used are as follows;

Young (US 4706121) application date May 6, 1986

Yuen et al (US 5307173) application date February 3, 1992.

Hence all references predates the applicants current invention application date together with the claimed benefit of prior invention, which is March 19, 1993.

Therefore claims 1 – 14 stay rejected.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 - 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young (US 4706121) in view of Yuen et al (US 5307173)

Regarding **claim 1**, Young discloses a system for controlling a television tuner (fig 3) comprising:

an on-screen television (fig 3, 126 illustrates on-screen television) scheduling system separate from the television tuner (col 7, lines 17 – 21 illustrate separate program and schedule) configured to generate a display of television schedule information including listings of television programs in a guide format (col 7, lines 39 – 42 illustrates supplying television schedule for display and col 7, lines 5 - 10 illustrate a tv guide format) and receive a user selection of a displayed television program listing as a first channel selection command unrecognizable by the television tuner (col 12, lines 18 – 21, col 16, lines 38 – 44 and col 20, lines 59 – 64 illustrate unattended recording. This unattended recording is accomplished with the vcr remote connected to tv scheduler, hence the channel selection command is unrecognizable by tv tuner)

a control signal means for transmitting the second channel selection command to

Art Unit: 2621

the television tuner for causing the tuner to tune to the selected television program (col 7, lines 60 – 64 and col 20, lines 40 – 64)

However Young does not disclose means coupled to the on-screen television scheduling system for converting the first channel selection command to a second channel selection command recognizable by the television tuner

On the other hand, Yuen et al, teaches a conversion table stored in the memory for converting the assigned numbers of each cable channel of the television guide such as HBO, ESPN, etc. to the channel number of the local cable carrier in order to tune the VCR to the correct channel (col 16, line 53 to col 18, line 7)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the conversion table as taught by Yuen et al into the system of Young in order to accurately record the television program in attended recording mode.

Regarding **claim 2** the combination of Young and Yuen et al discloses all of the features of the instant invention as discussed in claim 1 above except for wherein the on-screen television scheduling system resides in a recording means.

On the other hand, Yuen et al further teaches that another preferred embodiment of the invention is to embed the decoding means into various equipments associated with television, such as a video cassette recorder, cable box or satellite receiver because the decoding means would only have to be present in one of the equipments, such as the cable box, which would then at the appropriate time distribute the power command to the other equipments such as VCR and a satellite receiver to record the desired program (figs. 32 – 35, col 32, line 42 to col 33, line 16 and col 33, line 62 to

Art Unit: 2621

col 34, line 45)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the capability of embedding the decoding means into various equipments associated with television as taught by Yuen et al into the system of Young in order to use only one controlling means in one of the equipments to control other equipments.

Claim 3 is rejected for the same reasons as discussed in claim 2 above because Yuen et al teaches that the decoding means can be embedded in the cable decoder (figs. 32 – 35, col 32, line 42 to col 33, line 16 and col 33, line 62 to col 34, line 45)

Claim 4 is rejected for the same reasons as discussed in claim 1 above because Yuen et al teaches the claimed memory storing a conversion code for converting the first channel selection command to the second channel selection command (col 16, line 53 to col 18, line 7)

Regarding **claim 5** Young discloses the claimed wherein the on-screen television scheduling system is configured to receive a desired activation time for the selected television program (col 7, line 60 to col 8, line 22, col 9, line 48 to col 10, line 10 and col 15, line 20 to col 16, line 44)

Regarding **claim 6** Young discloses the claimed wherein the control signal means transmits the second channel selection command at the activation time (col 7, lines 60 – 64 and col 20, lines 40 – 64)

Regarding **claim 7** Young discloses the claimed means for supplying recording commands to a recording means at the activation time (col 7, lines 60 to col 8, line 22

Art Unit: 2621

and col 20, lines 40 – 64)

Method **claims 8 – 14** are rejected for the same reasons as discussed in apparatus claims 1 – 7 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Y. H./
04/23/2009
/Thai Tran/
Supervisory Patent Examiner, Art Unit 2621